

REMARKS

Reconsideration of the application is respectfully requested in view of the above amendments and following remarks.

Claims 39-64 were pending in the present application. Claims 39-46 and 64 are rejected. Claims 47-52 are objected to. Claims 53-63 have been withdrawn from consideration by the Examiner. Claims 39, 46 and 64 have been amended. Claims 39-52 and 64 are currently pending in the present application.

Claim 39 has been amended to delete the definition of R² is C₁₋₁₀alkyl, and the Markush elements of R² have been renumbered. Claim 46 has been amended to delete the definition of R² is isopropyl, isobutyl, n-propyl, and n-butyl, and the Markush elements of R² have been renumbered. Claim 64 has been amended to depend from Claim 39 instead of Claim 1.

No new matter has been added to the above-captioned application by the above amendments.

Claim Rejections - 35 USC § 112

The Examiner stated that Claim 64 recites the limitation "according to Claim 1" in the first line of the claim and that there is insufficient antecedent basis for this limitation in the Claim since Applicant has canceled Claim 1.

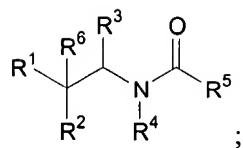
Applicants have amended Claim 64 to depend from Claim 39 and to recite "according to Claim 39."

In view of the above amendments, Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 64 under 35 USC 112.

Claim Rejections - 35 USC § 102

Claims 39, 40, 42 and 44 are rejected under 35 USC 102(b) as being anticipated by White et al. (US 4,360,519). The Examiner further stated that Claims 39-45 are rejected under 35 USC 102(b) as being anticipated by Novak et al. (Pesticide Science 1997, 49, 85-89).

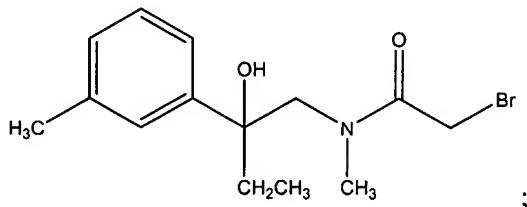
Amended Claims 39-45 of the instant case are drawn to compositions of formula I



(I)

and a pharmaceutically acceptable carrier.

The Examiner stated that White et al. (US 4,360,519, column 10, Example 6) teaches compositions comprising a compound of the following structure:



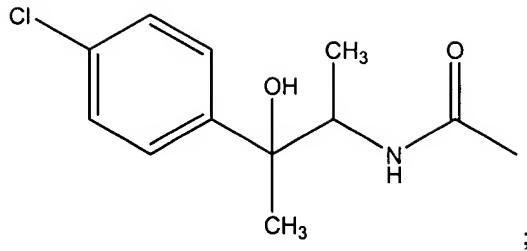
which corresponds to R¹ = 3-methoxy phenyl, R² = methyl, R³ = H, R⁴ = methyl, R⁵ = bromomethyl, and R⁶ = OH of Claims 39, 40, 42 and 44 of formula I of the instant case.

Applicants respectfully traverse the rejection of Claims 39, 40, 42 and 44 over White et al. White et al. discloses the cited compound as an intermediate in the preparation of "pharmaceutically" active morpholine derivatives. White et al. does not provide for compositions comprising the Example 6 compound and a pharmaceutically acceptable carrier. White et al. does not disclose a composition comprising a compound of Applicants' structural formula (I) and a pharmaceutically acceptable carrier.

Nevertheless, to expedite prosecution of the present application to allowance, Applicants have amended Claim 39 to delete the element C₁-10alkyl from the Markush group defining R². Amended Claim 39 excludes compositions which read on the species of the White reference. Claims 40, 42 and 44 are dependent on Claim 39, and incorporate the amendment to Claim 39.

As currently amended, the compositions of Claims 39, 40, 42 and 44 do not have a compound of formula (I) with a R² group that is C₁-4alkyl. Therefore, the compounds disclosed in the White reference do not fall within the scope of the amended Claim 39 and dependent Claims 40, 42 and 44 of the present invention.

The Examiner further stated that Novak et al. (Pesticide Science, 1997, 49, 85-89, page 86, Fig 1, compound 3a) teaches:



which corresponds to R¹ = chlorophenyl, R² = methyl, R³ = methyl, R⁴ = hydrogen, R⁵ = methyl, and R⁶ = OH of Claims 39-45 of the instant case formula I.

Applicants respectfully traverse the rejection of Claims 39-45 over Novak et al. Novak discloses the cited compound as a pesticide. Novak does not disclose a composition comprising a compound of Applicants' structural formula (I) and a pharmaceutically acceptable carrier.

Nevertheless, to expedite prosecution of the present application to allowance, Applicants have amended Claim 39 to delete the element C₁-10alkyl from the Markush group defining R². Amended Claim 39 excludes compositions which read on the species of the Novak reference. Claims 40-45 are dependent on Claim 39, and incorporate the amendment to Claim 39.

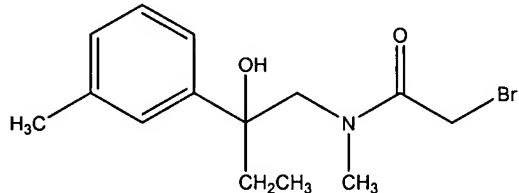
As currently amended, the compositions of Claims 39-45 do not have a compound of formula (I) with a R² group that is C₁-4alkyl. Therefore, the compounds disclosed in the Novak reference do not fall within the scope of the amended Claim 39 and dependent Claims 40-45 of the present invention.

In view of the above amendments, Applicants respectfully submit that the present Claims are novel and request reconsideration and withdrawal of the rejection of Claims 39-45 under 35 USC 102(b).

Claim Rejections - 35 USC § 103

Claim 46 is rejected under 35 USC 103(a) as being unpatentable over White et al. (US 4,360,519).

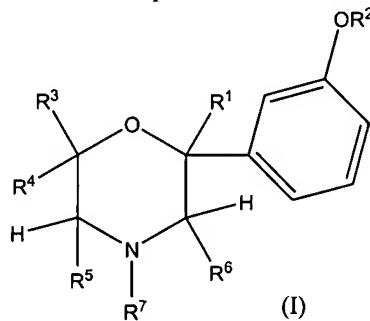
The Examiner stated that White et al. teaches the following structure in column 10 as Example 6:



The Examiner also stated that in the above structure an ethyl group is located in the position that the instant Claim 46 defines as R²; and that in the instant Claim 46, ethyl is not included in the definition of R². The Examiner further stated that Claim 46 defines R² as n-propyl, which differs from ethyl by one -CH₂- group and that they are therefore adjacent homologues. The Examiner indicated that adjacent homologs are considered to be obvious absent **unexpected results** (In re Henze, 85 USPQ 261, 263 (CCPA 1950)).

Applicants submit that Claim 46 of the instant application is not *prima facie* obvious over US 4,360,519 (White et al.).

US 4,360,519 discloses and claims morpholine derivatives of formula (I):



and their use as analgesics or opiate antagonists. US 4,360,519 discloses Example 6 as an intermediate to make the therapeutically active morpholine derivatives of formula (I) useful as analgesics or opiate antagonists.

Applicants submit that the cited White compound Example 6 does not have utility other than as an intermediate. White does not teach or suggest a composition comprising a compound of Applicants' invention with a pharmaceutically acceptable carrier. Therefore, the compositions of original Claim 46 are not *prima facie* obvious.

Nevertheless, to expedite prosecution, Applicants have amended Claim 46 to delete the elements isopropyl, isobutyl, n-propyl, and n-butyl from the Markush group defining R².

Applicants submit that amended Claim 46 is not *prima facie* obvious, and respectfully request that the rejection under 35 USC § 103(a) be withdrawn.

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Claims 47-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

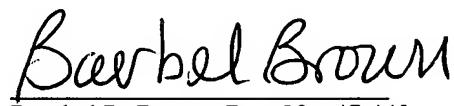
Applicants submit that Claims 47-52 are dependent on claims that depend from Claim 39, and incorporate the amendment to Claim 39.

In view of the amendment to Claim 39, Applicants respectfully submit that the present claims are novel and request reconsideration and withdrawal of the objection to Claims 47-52 as being dependent upon rejected base claims.

Applicants believe that all of the rejections have been overcome and therefore earnestly solicit an early Notice of Allowance.

Respectfully submitted,

By


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